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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,515	05/24/2001	Kazuhiro Kamemoto	P 280271 T4HW-00S0928P	9891
909	7590	10/06/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			BROWN, RUEBEN M	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/863,515		KAMEMOTO ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Reuben M. Brown		2611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 8/02/2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarfati, (WO 99/22516).

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Considering claim 18, the claimed digital broadcast receiver that receives digital broadcast data and performs reproduction on the digital broadcast data comprising:

‘a card slot into which a memory card having its built-in memory written with predetermined demonstration data can be plugged’, is met by the card reader 6, into which a subscription card may be inserted, page 8, lines 5-10.

‘a reproducer for, when the memory card is plugged into the card slot and a request is made to reproduce the demonstration data, to read from memory and reproduce the broadcast data, based on the processing of the demonstration data’, is met by the operation of Sarfati, which controls the display of broadcasts, based on the user’s subscription information, stored on the subscription card, page 14, lines 21-30.

Considering claim 19, the instant elements of a digital broadcast receiver substantially correspond with subject matter mentioned in the rejection of claim 18, and is likewise treated.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Allport, (U.S. Pat # 6,882,299).

Considering claim 20, the claimed remote controller which operates a remote controller so as to reproduce received digital broadcast data on the basis of contract information recorded on a memory card, wherein it is equipped with operating members, a display unit, and a card slot and has functions of; when the memory card (having program selecting data contained in the digital broadcast data written into its built-in memory) is plugged in to the card slot, displays the program selecting data on the unit and send program selecting data selected from the displayed contents on the basis of the operation of the operating members', is met by the operation of the remote control 10, which includes a display 85 and card slot, for receiving a smart card, which operates as a password, (col. 8, lines 40-60; col. 9, lines 9-25). Allport goes on to teach that the remote control 10 displays an EPG, from which user(s) may select a particular program for viewing, on any number of broadcast receiving device; see col. 9, lines 24-55; col. 10, lines 21-58; col. 12, lines 49-65).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobakht, (U.S. Pat # 6,745,223), in view of Sarfati (WO 99/22516).

Considering claims 1, 5 & 12, the claimed 'digital broadcast receiver that receives digital broadcast data and includes control means that reproduces the digital broadcast data on the basis of contract information recorded on a memory card plugged into a card slot', is met by the STB 131, that receives a smart card 232, into a smart card socket 215, see Fig. 2 & col. 6, lines 55-67; col. 13, lines 1-15 & col. 15, lines 1-10.

'a memory for data storage built into the memory card', reads on non-volatile memory 330, col. 6, lines 60-667 thru col. 7, lines 1-10 & Fig. 3B.

'interface means for being added to the control means which obtains program selecting data contained in the received digital broadcast data and writes the received digital broadcast data and writes the received digital broadcast data into the memory in the memory card plugged in to the card slot', Nobakht teaches that the channel table data downloaded to the STB 131, is

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stored in SDRAM 218; col. 14, lines 1-10 & col. 15, lines 5-35. However, Nobakht does not state that the data may also be transferred to memory on the smart card. Nevertheless Sarfati, which is in the same field of endeavor, teaches transmitting data and storing the instant data on one or more smart cards, see Abstract; page 8, lines 5-10; page 14, lines 20-25. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Nobakht with the feature of downloading and storing data on a smart card, as taught by Sarfati, at least for desirable improvement of updating the authorization information on the instant smart card.

Considering claims 2-3, the claimed 'adjustment data for each unit in the digital broadcast receiver', is met by the downloading of various applications that control the receiver; see Sarfati, page 12, lines 11-20; page 14, lines 21-30.

8. Claims 4, 11 & 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobakht & Sarfati, further in view of Allport, (U.S. Pat # 6,882,299).

Considering claim 4, even though both Nobakht & Sarfati disclose the use of a remote control device, neither reference teaches that the remote control has a slot for receiving a smart card and reproduces data in memory, when the smart card is inserted. However Allport, which is in the same field of endeavor, discloses a remote control 10 that includes a smart card for authenticating access to information stored on the instant remote control, col. 9, lines 10-15 & Fig. 5. It would have been obvious for one of ordinary skill in the art at the time the invention

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was made, to modify Nobakht with the feature of requiring a smart card for access to data using a remote control, for the improvement of a more secure system, as taught by Allport.

As for the additional features of a remote control equipped with operating members; a display unit; and a card slot and has functions of; when the memory card (having program selecting data contained in the digital broadcast data written into its built-in memory) is plugged in to the card slot, displays the program selecting data on the unit and send program selecting data selected from the displayed contents on the basis of the operation of the operating members', is met by the operation of the remote control 10, which includes a display 85 and card slot, for receiving a smart card, which operates as a password, (col. 8, lines 40-60; col. 9, lines 9-25). Allport goes on to teach that the remote control 10 displays an EPG, from which users may select a particular program for viewing, see col. 9, lines 24-55; col. 10, lines 21-58; col. 12, lines 49-65).

Considering claim 13-17, the claimed method for controlling, digital broadcast receiver, or remote control for controlling a digital broadcast receiver, comprising steps that substantially correspond with subject matter mentioned above in the rejection of claims 4 & 11, and are likewise analyzed.

9. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarfati.



Considering claim 6, the claimed 'digital broadcast receiver which receives digital broadcast data and performs reproduction on the basis of contract information on a first memory card plugged into a card slot', is met by the digital decoder (Fig. 1) which includes a card reader 6 that reads subscription data from a smart card, page 8, lines 5-10 & page 14, lines 21-25.

'a second memory card which has built in memory for data storage and can be plugged into the card slot, place of the first memory card', is met by the discussion in Sarfati, that the system may alternatively use only one card slot for two memory cards, page 16, lines 25-32.

'first means for reading the contract information from the first memory card plugged into the card slot to make a decision of whether to reproduce the received digital broadcast data', is met by the operation of Sarfati, page 8, lines 7-9.

'second means for, when it is decided by the first means that the reproduction of the broadcast is authorized, to prompt the viewer to insert the second card into the card slot' reads on Sarfati, which teaches that the subscription card is first used to gain access to the system, then the institution card is used, page 8, lines 5-10. However, Sarfati does not explicitly state that he user is 'prompted'. Official Notice is taken that at the time the invention was made, providing a visual prompt was old in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Sarfati with the feature of providing a visual prompt

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for the user, at least so the instant user would know when to insert the next card, i.e. more efficiently facilitate the transaction.

'third means for performing a control operation so that data obtained by reproducing the received digital broadcast data is written it o the second card is met by, Sarfati page 8, lines 8-10; page 14, lines 21-30 & page 15, lines 1-15.

Considering claims 7-9, the instant claims comprise elements that substantially correspond with subject matter mentioned above in the rejection of claim 6, and are likewise treated.

Considering claim 10, Official Notice is taken that forcedly ejecting a device was old in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Sarfati with the feature of forcedly ejecting smart card, for the purpose of the user inserting the next card.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Chaney Teaches a Set top box with slots for multiple smart cards.

B) Manowitz Downloading control data to a smart card associated with a remote control.

C) Darbee Remote control with display and smart card.

D) Nemirofsky TV with smart card.

E) Kudelski Generic TV system with smart card.

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**Any response to this action should be mailed to:**

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P.O. Box 1450  
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[www.uspto.gov](http://www.uspto.gov)

**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**


(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

  
REUBEN M. BROWN  
PATENT EXAMINER